

REMARKS/ARGUMENTS

Upon entry of the present response, the pending claims will not have been amended, and claims 24-26, 28, 30-32, and 34-42 will remain pending and are submitted for reconsideration by the Examiner.

In view of the above, Applicants respectfully request consideration of the outstanding rejection of the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicants would like to express their appreciation to the Examiner for the detailed Official Action provided, and for the indication of the allowability of claims 28, 31 and 32 in the present application.

Turning to the merits of the action, the Examiner has rejected claims 24-26, 30, and 33-34 under 35 U.S.C § 102(e) as being anticipated by FEDER (U.S. Patent No. 5,872,845).

As noted above, Applicants have not amended the pending claims. Thus, claims 24-26, 28, 30-32, and 34-42 remain pending for consideration. However, Applicants respectfully traverse the above rejection based on pending claims 24-26, 30-32, and 34-42, and will discuss the rejection with respect to the pending claims in the present application as will be set forth hereinbelow.

Applicants' claims 24-26, 34-35, 37, 39 and 41 relate to a server apparatus connected with a transmitting Internet facsimile apparatus and with a receiving Internet facsimile apparatus via the Internet. The server apparatus includes a memory configured to store reception capabilities regarding a type of facsimile data that the receiving Internet facsimile apparatus can receive. The reception capabilities are distinct from the facsimile data and the receiving Internet facsimile apparatus is distinct

from the server apparatus. The server apparatus includes a controller configured to receive facsimile data from the transmitting Internet facsimile apparatus. The controller transforms the received facsimile data into a type of facsimile data that the receiving Internet facsimile apparatus can receive, based on the stored reception capabilities of the receiving Internet facsimile apparatus, and transmits transformed facsimile data to the receiving Internet facsimile apparatus. Claims 30, 36, 38, 40 and 42 recite related methods.

In direct contrast, FEDER relates to fax transmission over a packet-switched digital communication network. Fig. 1 of FEDER describes that when the first machine 110 transmits a fax message to the second fax machine 170 using digital communication, the first interface apparatus 120 intercepts the fax message, enhances its data compression, and transmits it as an image data file using a data modem. The message is sent from the first interface apparatus 120 to a local server 130. The local server receives the message, encapsulates it within a data file, and forwards it to network 140 which delivers the message to the remote server 150. Fig. 1 of FEDER also teaches that upon receiving the message from the network, the remote server 150 de-encapsulates the image data file and transmits it to the second interface apparatus 160, which converts the image data file to a conventional fax message format and transmits it to a second fax machine 170.

As Applicants have discussed in the response to an Official Action dated January 14, 2004, in which FEDER was cited and applied by the Examiner, Applicants again submit that the features recited in Applicants' pending claims are not taught in FEDER cited by the Examiner.

At col. 10, lines 4-25, FEDER discloses that when the destination fax machine 570 does not have the interface installed therein, the remote server 550 associated with the destination fax machine 570 is utilized. The remote server 550 receives a message from a network 140, decompresses the message, and converts it to raw data. The remote server 550 re-encodes the data, dials the destination fax machine 570, and transmits the re-encoded data to the destination fax machine 570.

At col. 10, lines 26-32, FEDER discloses that when the remote server 550 receives the message, the remote server 550 re-encodes the message in several formats and "stores in memory data files created for each such format." In this case, when the destination fax machine 570 transmits the DIS to the remote server 570, the remote server 550 transmits an appropriate format to the destination fax machine 570 and erases the others stored in the memory.

This portion of the FEDER disclosure clearly indicates that FEDER does not comply with the recitations of Applicants' claims. In particular, as set forth in FEDER at the paragraph beginning at column 1, line 49, the digital identification signal (DIS) is transmitted by a receiving station to the transmitting station and contains information "indicating the data encoding capabilities of the receiving fax machine". Thus, if FEDER uses DIS (which is explicitly disclosed to be used therein), there is no reason to store capability information in a server since the DIS signal transmits such information from the receiver to the transmitter. Moreover, if capability information is stored in the memory of the server why would the message have to be encoded in several formats, only one of which is later to be used. For each of these reasons, it is respectfully submitted that the Examiner's rejection is based upon a faulty interpretation of the cited portion of the FEDER patent.

At col. 10, lines 33-44, FEDER discloses that the service maintains a registry of fax machines that have installed the interface of the invention. The interface may register such fax machines automatically once the interface has been properly coupled to the fax machine. The remote server computer “stores this information.”

In the rejection, the Examiner noted *inter alia* column 10, lines 41-42, which teach of “on the basis of the data stored therein” (emphasis supplied). However, as noted above, what is stored in the memory of the remote server 550, appears to be “data files created for each such format” or “this information” regarding fax machines that have installed the interface.

However, there is no teaching or disclosure in FEDER that the data stored comprises “reception capabilities regarding a type of facsimile data that the receiving Internet facsimile apparatus can receive” as recited, e.g., in Applicants’ claim 24.

Thus the disclosure that, “The service, in general, has a capability to determine, on the basis of the data stored therein, the capability of the intended recipient of the file and, according to the determined capability of the recipient, send the file in a suitable format.” (column 10, lines 33- 44 of FEDER) means that the service, in general, has a capability to determine, on the basis of the data file created for the appropriate format or the information regarding fax machines that have the interface installed therein, the capability of the intended recipient of the file and, according to the determined capability of the recipient, send the file in a suitable format.

However, Applicants’ claim explicitly recites that the reception capabilities are distinct from the facsimile data. Since, as noted above, the data file created for the appropriate format is used for determining the capabilities of the intended recipient, this

clearly does not satisfy the recitations of Applicants' claim. For this additional reason, Applicants' claims are submitted to be patentable over FEDER.

As noted above, what is stored in the memory of the remote server appears to be either "data files created for each such format" or "this information" regarding fax machines that have installed the interface.

However, in the case of the former (data files created for each format), since the remote server 550 erases the files in other than the appropriate format, the remote server 550 merely stores a "data file" created for the appropriate format, e.g. MH format. However, the "data file" created for the appropriate format does not contain information regarding a format appropriate for a recipient, e.g. MH itself. Although the server apparatus might be able to determine the capability of the intended recipient of the file based on the data file created for the appropriate format, the server apparatus does not transform the received facsimile data into a type of facsimile data that the receiving facsimile can receive based on the data file created for the appropriate format since it has already been transformed, as taught at column 10, lines 26-29. Further, the data file created for the appropriate format is not "capabilities regarding facsimile data that the receiving facsimile can receive. . . ., the reception capabilities being distinct from the facsimile data", as recited in claim 24 of the pending application.

In direct contrast to the recitations of claim 24, the capabilities of the receiving fax in FEDER are determined based on the DIS (col. 1, lines 54-58), but are not stored in a memory, as recited herein.

Accordingly, FEDER also does not transform the received facsimile data "based on the reception capabilities stored in the memory" as required by Applicants' claim.

On the other hand, in the case of the latter (i.e. information regarding fax machines), the remote server 550 stores the information regarding fax machines that have the interface installed therein. However, the stored information does not comprise “capabilities regarding facsimile data that the receiving facsimile can receive”, since the server apparatus can not transform the received facsimile data into a type of facsimile data that the receiving facsimile can receive, based on whether the called fax machine has the interface installed.

Therefore, Claim 24 of the pending claim is clearly distinguished from FEDER, since the memory of FEDER merely stores either the data file created for the appropriate format or the information regarding fax machines that have the interface installed, but does not store “capabilities” as recited in claim 24.

Therefore, it is respectfully submitted that the features recited in Applicants’ claims 24-26, 30 and 34-42 are not taught in FEDER cited by the Examiner.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection, and an indication of the allowability of all the claims pending in the present application in due course.

In this regard, should the Examiner persist in maintaining a rejection based on the FEDER reference, which has already been applied and overcome in several actions and responses in the present application, Applicants respectfully request that the Examiner indicate what basis she has for interpreting the “data stored therein” at column 10, line 43, of FEDER as referring to the capabilities of the machine rather than to data files created for each format or as referring to information regarding the installation of an interface in the receiving fax machine.

As noted above, the Examiner's interpretation of FEDER is incorrect at least because of the explicit disclosure of the use of the DIS signal by the system to transmit capability information of the receiving facsimile machine. In view of the use of the DIS signal, there is clearly no need to store capabilities in a server.

In the outstanding Official Action, the Examiner indicated claims 28, 31 and 32 as having been allowed. The Examiner is respectfully thanked for this indication. However, in view of the above, Applicants respectfully submit that all of the claims in the present application are clearly allowable over the FEDER reference cited by the Examiner.

Applicants further note the Examiner's Statement of Reasons for Allowance in the outstanding Official Action. In this regard, while Applicants do not disagree with any of the features cited therein, Applicants further wish to point out that each of the claims in the present application recite a particular combination of features and the patentability of each claim is thus based on the totality of features recited therein. Accordingly, the reasons for allowance should not be limited to those features emphasized and enumerated by the Examiner.

SUMMARY AND CONCLUSION

Applicants have made a sincere effort to place the present application in condition for allowance and believe that they have now done so. Applicants have not amended the rejected claims but have submitted them for reconsideration by the Examiner.

With respect to the pending claims, Applicants have pointed out the features thereof and have contrasted the features of the pending claims with the disclosures of the cited reference. Applicants have noted the specific recitations of the pending claims and have pointed out how these features are not satisfied by the recitations of the reference relied upon by the Examiner.

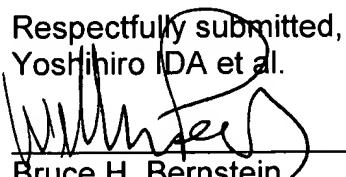
Accordingly, Applicants have provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully request an indication of the allowability of all the claims pending in the present application in due course.

The undersigned hereby authorizes the U.S. Patent and Trademark Office to charge any fees necessary to maintain the pendency of the above-identified application, including any extension of time fees and claim fees, to Deposit Account No. 19-0089.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

September 15, 2006
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191

Respectfully submitted,
Yoshihiro IIDA et al.


Bruce H. Bernstein
Reg. No. 29,027

William Pieprz
Reg. No. 33,630